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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/839,161	04/22/1997	WILLIAM P. NEWTON		9755

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

08/839,161

Applicant(s)

NEWTON ET AL.

Examiner

Gregory J. Strimbu

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) 26-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 39-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

***Specification***

The amendment filed December 7, 1998 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: so that the sash weight does not subject the sash shoes to moment arms tending to turn the sash shoes about horizontal axes. See lines 14-18 of page 7 which set forth only a minimization of the moment arms tending to turn the sash shoes about horizontal axes.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

Claims 12-25 and 39-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "a hook-shaped upper region" on lines 8-9 of claim 12 render the claims indefinite because it is unclear what element of the invention includes the region to which the applicant refers. Recitations such as "the elevational configuration" on line 1 of claim 19 render the claims indefinite because it is unclear what the applicant is attempting to set forth. What comprises an "elevational configuration"? Recitations such as "the shoe" on line 2 of claim 19 render the claims indefinite because it is unclear to which one of the plurality of shoes set forth above the applicant is referring. Recitations such as "a jamb" on line 2 of claim 19 render the claims indefinite because it

Art Unit: 3634

is unclear if the applicant is referring to one of the jambs set forth above or is attempting to set forth another jamb in addition to the ones set forth above. Also see line 2 of claim 24, line 9 of claim 53, line 2 of claim 55, lines 5 and 8 of claim 61, line 2 of claim 84, and lines 9 and 15 of claim 86 which suffer the same indefiniteness. Recitations such as "the profile configures" on line 1 of claim 20 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Recitations such as "the shoe hook" on line 3 of claim 21 render the claims indefinite because they lack antecedent basis. Recitations such as "size" on line 2 of claim 25 render the claims indefinite because it is unclear what element has the size to which the applicant refers.

Recitations such as "the braced support arms" on line 3 of claim 55 render the claims indefinite because they lack antecedent basis. Recitations such as "one of the support arms being secured to each sash stile" on lines 6-7 of claim 67 render the claims indefinite because it is unclear how one support arm can be attached to each sash stile.

Recitations such as "biased upward" on line 5 of claim 74 render the claims indefinite because it is unclear if the phrase modifies the support arms or the sash shoes.

Recitations such as "lifting regions" on line 5 of claim 74 render the claims indefinite because it is unclear what element includes the lifting regions to which the applicant refers. Recitations such as "sash stiles" on line 6 of claim 80 render the claims indefinite because they lack antecedent basis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39-41 and 44-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Osten. Osten discloses a sash support system comprising a plurality of sash support elements each formed of a metal having a profile establishing a respective configuration of each element, the configuration of a first one of the elements forming a shoe 92 extending integrally from a hook shaped upper region 82 engaging a counterbalance 78 to a platform shaped lower region 102 supporting a sash 20, the configuration of a second one of the elements 50 forming a sash support arm pivotally connected to a stile of the sash to engage the platform shaped lower region of the shoe, a shoe lock 98 (claim 40), a pin 106 (claim 41), a guide 110 (claim 45), a mounting bracket 36, 38 (claim 48).

Claims 74-85 are rejected under 35 U.S.C. 102(b) as being anticipated by Osten. Osten discloses a system counterbalancing a laterally removable sash 20 supported by counterbalanced sash shoes 92 respectively running vertically in opposed jambs arranged along opposite stiles of the sash, the system comprising support arms 50 pivotally mounted on the sash to extend between the sash and sash shoes 92 biased upward at lifting regions spaced from each sash stile, the support arms being arranged

Art Unit: 3634

for transferring the weight of the sash to the shoes at support regions (not numbered, but shown in figure 1) vertically below the lifting regions to minimize any moment arms tending to turn the shoes around horizontal axes, and the support arms moving to downwardly hanging positions upon movement of the sash upward and laterally from the shoes, the shoes 92 are formed of metal (claim 76), the support arms 50 are formed of metal (claim 77).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15, 19, 20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Haas. Osten discloses a system counterbalancing a window sash 20 supported by a pair of counterbalanced shoes 92 so that the sash extends between a pair of jambs from which the sash is removable by maneuvering the sash upward and laterally while the shoes are locked in the jambs, the improvement comprising the shoes having a predetermined profile extending for a width of the shoes and establishing configuration of the shoes, and the configuration extending integrally between a hook-shaped upper region 82 formed to interconnect with a counterbalance element 78 and an lower region 102 forming a platform extending toward the sash from vertically below the upper region, sash support arms 50 (claim 13), the shoes include

Art Unit: 3634

locking projections 98 (claim 16), a support guide 88 (claims 19, 20). Osten is silent concerning an L-shape.

However, Haas discloses shoes 65 having an L-shaped configuration.

It would have been obvious to one of ordinary skill in the art to provide Osten with an L-shaped configuration, as taught by Haas, to increase the locking force of the shoes.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Haas as applied to claims 12-15, 19, 20 and 22-24 above, and further in view of Westfall '795. Westfall '795 discloses jamb projections 60.

It would have been obvious to one of ordinary skill in the art to provide Osten, with jamb projections, as taught by Westfall '795, to more securely hold the shoes in a locked position.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Haas and Westfall '795 as applied to claim 16 above, and further in view of Johnson. Johnson discloses a locking element 19 pivotally mounted on a shoe 13.

It would have been obvious to one of ordinary skill in the art to provide Osten, as modified above, with a pivotally mounted locking element, as taught by Johnson, to further increase the locking force of the shoe.

Art Unit: 3634

Claims 61, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten in view of Westfall '795. Osten discloses a system locking counterbalance shoes 84, 92 to window jambs while a sash 20 supported on the shoes is removed from between the window jambs, the system comprising the shoes having hooks 92 that are pivotally mounted on lower regions of the shoes to move between latched and unlatched positions, the hooks in unlatched positions hanging dependently downward from the shoes to engage the jambs, the hooks in latched positions being retained out of engagement with the jambs. Osten is silent concerning lances.

However, Westfall '795 discloses a locking counterbalance system comprising lances 60.

It would have been obvious to one of ordinary skill in the art to provide Osten with lances, as taught by Westfall '795, to provide a better locking engagement between the window jambs and the shoes.

### ***Allowable Subject Matter***

Claims 1-11 are allowed.

Claims 18, 21, 42, 43, 53-60, 62, 63, 66-73 and 86-90 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, if any, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of



Art Unit: 3634

elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a sash, opposed window jambs, and a pair of sash support arms mounting to hang freely downward on respective opposite sides of the sash. See claim 1, lines 4.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a window sash, a pair of counterbalanced shoes wherein the locking elements formed as hooks that catch on the jamb projections and the shoes have latches that latch the locking elements in undeployed positions out of engagement with the window jambs. See claim 18, lines 1-4.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the combination of a window sash, a pair of counterbalanced shoes wherein the profile having a latch retaining groove and a pin groove for receiving a pivot pin of the shoe hook. See lines 1-3 of claim 21.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach a resilient latch mounted on the shoe for retaining the shoe in the undeployed position. See lines 1-2 of claim 42.

Art Unit: 3634

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach sash support arms movably mounted respectively on each stile of a sash so that the support arms hang downward in dependent positions when not supporting the sash and move outward to braced positions in response to engagement of the support arms with locked sash shoes as the sash is lowered between the shoes so that the weight of the lowered sash urges the sash support arms outward on the shoes to the braced positions. See lines 2-9 of claim 53.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach resilient latches carried on the shoes for holding the hooks in the latched positions. See lines 1-2 of claim 62 and lines 1-3 of claim 66.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach the sash having a support arm secured to each sash stile so that the sash support arms hang downward in positions in which lower ends of the support arm engages sash end regions of the shoe platforms when the sash and the support arms are moved downward from above the shoe platforms, the sash support arms being mounted on the sash to pivot between the downwardly hanging position and

Art Unit: 3634

outwardly extending positions as weight of the downwardly moved sash transfers to the shoes via the support arms. See lines 8-19 of claim 67.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach sash uplifted positions in which the support arms hang downward from the sash stiles and allow lateral movement of the sash between the shoes, counterbalancing lifting region for the shoes being arranged vertically above support regions that uphold the weight of the sash transferred via the support arms to the shoes so that the sash weight does not subject the sash shoes to moment arms tending to turn the sash shoes about horizontal axes. See lines 7-13 of claim 86.

### ***Conclusion***

**THIS ACTION IS NOT MADE FINAL.**

### ***Response to Arguments***

Applicant's arguments, filed January 23, 2004, have been fully considered but they are not persuasive.

With respect to the applicant's arguments concerning Osten and claim 39, the examiner respectfully disagrees. The sash support arms 50 of Osten could be manufactured by first extruding the general shape of the arm 50, as shown in figure 1, then drilling the sockets 54, and, finally, cutting the extrusion to produce each individual

arm. It should be noted that the applicant's system cannot be produced by an extrusion process alone. At least one other step is required to manufacture the applicant's product. Lastly, the recitations referring to extrusion are merely product-by-process limitations. Therefore, as long as a reference teaches the product, it anticipates the claimed invention. Osten discloses a sash shoe 92 which extends integrally from the hooked shaped upper region 82 since they both comprise one unit as shown in figure 1. The term "integral" does not require a homogeneous structure, but rather only requires a complete whole. Because Osten discloses a sash shoe 82, 92 comprising a complete whole, Osten discloses an integral structure.

The applicant's comments concerning claims 74-90 are moot in view of the new grounds of rejection.

With respect to the applicant's arguments regarding claims 12-15, 19, 20 and 22-25, the examiner respectfully disagrees. The shoes 92 of Osten could be manufactured by first extruding the general shape of the shoes 92, as shown in figure 1, cutting the extrusion to produce each individual shoe, and then drilling the holes for pin 106. It should be noted that the applicant's system cannot be produced by an extrusion process alone. At least one other step is required to manufacture the applicant's product. Lastly, the recitations referring to extrusion are merely product-by-process limitations. Therefore, as long as a reference teaches the product, it anticipates the claimed invention. Additionally, Osten discloses an integral system because all the components thereof are connected together to form a complete whole as shown in figure 1.

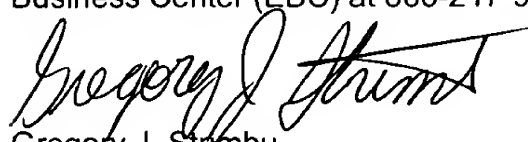
The applicant's comments concerning claims 16 and 17 are moot in view of the new grounds of rejection.

The applicant's comments concerning claims 61, 64 and 65 are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
July 1, 2004